

Appl. No. 09/864,965  
Amdt. dated September 8, 2003  
Reply to Office Action. of June 17, 2003

### **REMARKS/ARGUMENTS**

This paper is filed in response to the Office Action mailed June 17, 2003. Applicant notes that claims 24-28 have been withdrawn because of a prior election/restriction requirement. Currently, claims 1-23 are pending in the application. The Examiner of June 17, 2003 rejected claims 1-5 and 7-19 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,041,256 issued to Petty *et al.* (hereinafter "Petty"). Claim 6 was also rejected under §103(a) as being unpatentable over Petty in view of U.S. Patent No 4,923,388 issued to Nakamura (hereinafter "Nakamura"). Finally, claims 20-23 were rejected under §103(a) as being unpatentable over Petty.

In view of the following remarks, claims 1-23 are presented for reconsideration by the Examiner.

### **REJECTION OF CLAIMS 1-5 AND 7-19**

The standard of patentability under § 103 as set forth by the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966), is as follows: "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art is resolved. ... Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter to be patented." In determining the scope and content of the prior art and the differences between the claimed invention and the prior art, the PTO has the burden of establishing a *prima facie* case of obviousness. MPEP §2142. To establish a *prima facie* case of obviousness, the Examiner must produce (1) some suggestion or motivation to modify the reference or to combine reference teachings, (2) a reasonable expectation of success, and (3) the reference or references must teach or suggest all of the claim limitations. *Id.*

As an example of the claims at issue, independent claim 1 is for an injection mold inner core die comprising:

a window mold member projecting from a surface of the inner core die and configured to define a window in an interior wall of a piece being molded by the die, wherein the window mold member is configured to separate the interior wall of the piece being molded from the surface when the molded piece and inner core die are separated.

### **1. Scope and Content of the Prior Art**

In the Office Action, the Examiner rejected claims 1-5 and 7-19 under §103(a) as being unpatentable over Petty. *See* Office Action ¶ 3. Petty discloses a method for forming a plastic pipe connector. The plastic pipe connector includes a U-shaped cutout 17 that helps define a locking member 9. Petty col. 2, lines 60-62. More specifically, “the external mould 15 comprises a moving core 16 which forms the U-shaped cut-out 17, as shown in FIG. 1.” Petty col. 2, lines 60-62. As is clear from Figure 3a, the moving core 16 is slid through the external mold 15 and inserted into a recess in the internal mandrel 19. Once a “mould connector has sufficiently solidified, the external mould 15 and its [moving core] 16 are withdrawn as shown in FIG. 3b and the [internal mandrel] 19 is withdrawn in the direction of the arrow 16.” Petty col. 3, lines 3-7.

### **2. Differences Between the Claimed Invention and the Prior Art**

The claimed invention and Petty differ in that Petty fails to teach “a window mold member projecting from a surface of the inner core die.” Application, claim 1. Petty instead teaches “a moving core 16 which forms the U-shaped cut-out 17, as shown in FIG. 1.” Petty col. 2, lines 60-62. Figure 3a and 3b show the moving core 16 as extending through an external mold and seated in a recess in the internal mandrel 19.

Furthermore, Petty fails to teach a window mold member “configured to define a window in an interior wall of a piece being molded by the die.” Application, claim 1. Petty only

discloses molding a U-shaped cutout into a single walled pipe as shown in Figures 1, 2, 3a, 3b, and 3c. Petty does not disclose an interior wall of a piece being molded.

### **3. Failure to Establish a Prima Facie Case of Obviousness**

The Examiner has failed establish a *prima facie* case of obviousness. First, the Examiner has failed to produce a suggestion or motivation to modify Petty. Second, Petty fails to teach or suggest all of the claim limitations. Therefore, the Applicant respectfully asserts that the §103(a) rejection is improper.

#### **A. Failure to Produce a Suggestion or Motivation to Modify Petty**

There is no suggestion or motivation in Petty to modify Petty to form the U-shaped cutout 17 by using a "window mold member projecting from a surface of the inner core die." Application, claim 1. The Examiner instead asserted, "It would have been obvious to one of ordinary skill in the art to modify Petty with the mold member on the inner mold core because it is merely a relocation of parts." Office Action ¶ 3. However, MPEP § 2144.04 quotes *Ex Parte Chicago Rawhide Manufacturing Co.*, which states:

The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. 223 USPQ 351, 353 (BD. Pat. App. & Inter. 1984).

Therefore, the Examiner's assertion is not an appropriate basis for a §103(a) rejection.

In fact, Petty teaches away from the claimed invention. Petty teaches "the external mould 15 comprises a moving core 16 which forms the U-shaped cut-out 17, as shown in FIG. 1." Petty col. 2, lines 60-62. As is clear from Figure 3a and 3b, the moving core 16 is an insert mold separate from the inner core die and the external mold 15. Petty teaches away from the claimed invention because the invention allows the U-shaped cutout (window) to be formed using only the inner core die and the external mold. The moving core 16 is therefore not

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necessary. As is stated in the MPEP §2144.04, "Note that the omission of an element and retention of its function is an indicia of unobviousness." *See In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966).

**B. Failure to Teach or Suggest Claim Limitations**

To establish a *prima facie* case of obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974); MPEP §2143.03. As stated by the Examiner, "Petty fails to teach an inner core and inner core shape." Office Action ¶ 3. More specifically, Petty fails to teach or suggest a "window mold protruding from a surface of the inner core die," a window mold "configured to define a window in an interior wall of a piece being molded by the die," and a window mold "configured to separate the interior wall of the piece molded when the molded piece and inner core die are separated." Application, claim 1.

Even if Petty were modified as the Examiner suggests, modified Petty would still fail to teach "an interior wall of the piece being molded by the die." *Id.* Petty only discloses a tube having a single wall. An interior wall is not disclosed or suggested. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970); MPEP §2143.03. In accordance with the reasons given above, Petty does not render claims 1-5 and 7-19 *prima facie* obvious under §103(a). Withdrawal of this rejection is respectfully requested.

**REJECTION OF CLAIM 6**

As described in greater detail above, the Examiner rejected dependent claim 6 under 35 U.S.C. §103(a) as being unpatentable over Petty and Nakamura. *See* Office Action ¶ 4. Nakamura discloses an injection metal mold, but does not disclose every limitation of claim 6. However, it is well settled that if an independent claim is patentable over the cited prior art, then all claims that depend from that independent claim are similarly patentable. *See In re Sernaker*, 217 USPQ 1, 3 (Fed. Cir. 1983); *Hartness International, Inc. v. Simplimatic Engineering Co.*, 2

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USPQ2d 1826, 1831 (Fed. Cir. 1987). As discussed above, independent claim 1 is patentable over the cited references. Therefore, claim 6, which depends from independent claim 1, is similarly patentable. Withdrawal of this rejection is respectfully requested.

### **REJECTION OF CLAIMS 20-23**

As an example of the claims at issue, independent claim 20 is for an airbag injection mold inner core die comprising:

a back connected to an injection mold;  
a front,  
one or more sides to connect the front to the back,  
a window mold member disposed on a side and configured to form a window within a wall of a molded airbag cover; and  
a pair of ramps connected to the window mold member and configured to slope from the front toward the back.

#### **1. Scope and Content of the Prior Art**

In the Office Action, the Examiner rejected claims 20-23 under § 103(a) as being unpatentable over Petty. *See* Office Action ¶ 5. As noted above, Petty discloses a method for forming a plastic pipe connector. More specifically, Petty discloses an "external mould 15 comprises a moving core 16 which forms the U-shaped cut-out 17, as shown in FIG. 1." Petty col. 2, lines 60-62.

#### **2. Differences Between the Claimed Invention and the Prior Art**

As stated by the Examiner in the Office Action ¶ 5, "Petty fails to teach back, front, and one or more sides, boss, ramps and plurality of windows." Petty does teach an external mold 15 and an internal mandrel 19.

A difference not mentioned by the Examiner between Petty and the claimed invention is that Petty fails to teach "a wall of a molded airbag cover." Application, claim 20. Petty only discloses a plastic pipe connector.

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### **3. Failure to Establish a Prima Facie Case of Obviousness**

The Examiner has failed establish a *prima facie* case of obviousness. The Examiner has failed to produce a suggestion or motivation to modify Petty. Therefore, the Applicant respectfully asserts that the §103(a) rejection is improper.

#### **A. Failure to Produce a Suggestion or Motivation to Modify Petty**

There is no suggestion or motivation in Petty to modify Petty to include a pair of ramps. As noted by the Examiner, "Petty fails to teach ... ramps." Office Action ¶ 5. The Examiner instead asserted, "The prongs of the U-shape are the 'ramps' in Petty ... It would have been obvious to one of ordinary skill in the art to modify Petty with the U-shaped window mold member to be sloped because it is merely a change in form and shape. In re Dailey et al, 149 USPQ 47 (CCPA 1966)." Office Action ¶ 5. However, MPEP § 2144.04 states, "If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection."

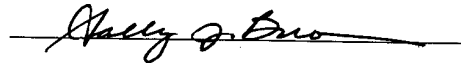
In this case, "The ramps 64 separate the interior wall 32 from the surface 62 such that the window 36 is unobstructed by the window mold member 60." Application page 20, lines 4-7. Furthermore, *Ex Perte Chicago Rawhide Manufacturing Co.*, a case cited by the MPEP § 2144.04, states, "The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." 223 USPQ 351, 353 (BD. Pat. App. & Inter. 1984); *See also In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Therefore, the Examiner's assertion is not an appropriate basis for a §103(a) rejection. Withdrawal of this rejection is respectfully requested.

### **CONCLUSION**

In view of the foregoing, the Applicants submit that claims 1-23 are in a condition for immediate allowance. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

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Respectfully submitted,



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